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February 7, 2005

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The Honorable Denis R. Hurley
United States District Court
100 Federal Plaza
Central Islip, New York 11722

Re: *Robert Novak v. Overture Services Inc, et al.*
Case No. CV 02 5164

Your Honor:

We represent defendant Google Inc. By order dated January 20, 2005, the Court directed the parties to submit letters addressing: (1) whether Plaintiff may retroactively condition his previous agreement to dismiss the case on the dismissal being without prejudice; (2) whether and how this Court's failure to close the case when requested affects the considerations in Issue (1); and (3) assuming that it is within this Court's discretion to decide, whether on the underlying merits and pursuant to Federal Rule of Civil Procedure 41, dismissal of this case should be with or without prejudice.

1. Plaintiff's Request to Condition His Agreement to Dismiss the Case

Plaintiff's December 20, 2004 Notice of Voluntary Dismissal is a unilateral and unconditional request, following Google's answer, to dismiss his claims in their entirety. As a result, the Court may dismiss the claims "upon such terms and conditions as the court deems proper." Fed. R. Civ. P. 41(a)(2). Plaintiff now seeks retroactively to qualify or withdraw the Notice of Voluntary Dismissal and, in particular, to deny the Court discretion to dismiss his claims with prejudice.

There is no basis for this request, except perhaps Plaintiff's own regret. Plaintiff is an unusually experienced litigant who, like all parties, is accountable for his court filings. Allowing Plaintiff to qualify or withdraw his dismissal request, after the fact, will only encourage further vexatious litigation against Google and others. Indeed, in a February 1, 2005 letter to Google's counsel Plaintiff requests discussion of "compensation" to him in order to avoid the possibility of "having this case renewed at a later date to include prior claims ..."

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2. The Effect of the Court Not Yet Closing the Case

The brief passage of time following the Court's Order to close the case should have no impact on whether Plaintiff may now retroactively place conditions on his dismissal. No deadlines have been affected by the Order. Neither Google nor Plaintiff has been impacted at all. (Notably, the deadline for serving discovery in the case -- December 15, 2004 -- had already passed when Plaintiff requested a dismissal. Plaintiff served no discovery at all).

3. Dismissal of Plaintiff's Claims With Prejudice

"[A] district court does not abuse its discretion by dismissing with prejudice when the request for dismissal does not specify whether it is to be with or without prejudice. Furthermore, dismissals without prejudice are usually granted only if the plaintiff pays expenses incurred by the defendant in defending the suit. When a plaintiff seeks a dismissal but asks the court to waive costs, then a court may be justified in construing the request as one for a dismissal with prejudice." *Moore's Federal Practice 3d*, § 41.40[10][d][vii]. The Second Circuit applies various factors to this determination: (1) the plaintiff's diligence in bringing the request; (2) any 'undue vexatiousness' on plaintiff's part; (3) the extent to which the suit has progressed, including the defendant's efforts and expenses in preparation for trial; (4) the duplicative expense of relitigation; and (5) the adequacy of plaintiff's explanation for the need to dismiss. *Zagano v. Fordham University*, 900 F.2d 12, 14 (2d Cir. 1990).

Plaintiff filed this *pro se* action almost two and a half years ago, on September 24, 2002. He identified himself as his sole witness. He sought no discovery. He refused to respond to Google's discovery demands (requests for production, interrogatories, and requests for admission), ignoring Google's repeated follow-up inquiries. As a result, he has made key admissions undermining his claims and waived all discovery objections. Moreover, as set forth in Google's July 23, 2004 letter to the Court (seeking leave to move for judgment on the pleadings), his claims fail as a matter of law. If necessary, and if leave is granted, Google is prepared to file its dispositive motion; the Court's scheduling order sets a February 15, 2005 deadline for such filings.

The fact that Plaintiff made his dismissal request two and a half years into the case, his history of vexatious litigation (in this action and others in this Court), the significant costs incurred by the defendants to date, the likely expenses associated with relitigation, and the absence of any explanation for a need to dismiss without prejudice all weigh heavily in favor of dismissal with prejudice.

4. Google's Counterclaim

Google respectfully requests that its counterclaim petitioning the Court to cancel Plaintiff's trademark registration be dismissed without prejudice.

Respectfully submitted,

/s/ John L. Slafsky

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